REMARKS

Claims 1-7, 10-18 and 20-23 are pending in the present application. By this response, claims 1 and 13 are amended to correct minor informalities and for clarification of the subject matter being claimed. Reconsideration of the claims in view of the above amendments and the following remarks is respectfully requested.

I. 35 U.S.C. § 102, Alleged Anticipation, Claims 1-7, 10-18 and 20-23

The Final Office Action rejects claims 1-7, 10-18 and 20-23 under 35 U.S.C. § 102(b) as being anticipated by Mendez et al. (U.S. Patent No. 5,961,590). This rejection is respectfully traversed.

As to claims 1, 13, and 23, the Office Action dated November 4, 2004, states:

> As per claims 1,13,23 Mendez disclosed a mail server for initiating database synchronization with a client on a mobile computing device, comprising: a mail server copy of a user mailbox, wherein a copy of said user mailbox also exists on the client; means for receiving a message for said user at the mail server; means for storing the message in said user mailbox on the mail server; means, responsive to receipt of said message at the mail server (col. 12, lines 29-39), for initiating a link between the mail server and the client; and means for transmitting synchronization updates to the client in order to synchronize the client copy of said mailbox with the mail server copy, such that message is added to the client copy of the mailbox and means for transmitting synchronization updates to the client in order to synchronize the client copy of said mailbox with the mail server copy (col. 12, lines 1-8), such that said message is added to the client copy of the mailbox, responsive to receipt of said message at the mail server, for initiating a link between the mail server and the client (col. 12, lines 20-28). Wherein the step of initiating the link comprises: creating a first trigger messaging to a message server, at the message server, transmitting a second trigger message to the client using a first protocol responsive to receipt of the first trigger message, at the client initiating a mail box synchronize request to the mail server using a second protocol in response to the receipt of the second trigger message; and wherein the method further comprises synchronizing the client copy of said mailbox with the mail server copy using the second protocol (col. 15 lines 12-53).

Claim 1, which is representative of the other rejected independent claims 13 and 23 with regard to similarly recited subject matter, reads as follows:

> 1. A method for performing server initiated database synchronisation between a mail server and a client on a mobile computing device, the method comprising the steps of:
> providing the mail server and the client each with a user mailbox, wherein the mail server mailbox includes a remote device id for identifying the client;
> receiving a message for said user at said mail server;
> storing the message in said user mailbox on said mail server;
> responsive to receipt of said message at the mail server, initiating a link between said mail server and said client using said remote device id, and wherein the step of initiating the link comprises:
> creating a first trigger message,
> transmitting said trigger message to a message server,
> at the message server, transmitting a second trigger message to the client using a first protocol responsive to receipt of the first trigger message,
> at the client, initiating a client mailbox synchronise request to the mail server using a second protocol in response to the receipt of the second trigger message; and
> synchronising the client mailbox with the mail server mailbox using the second protocol such that said message is added to the client mailbox.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re bond*, 910 F .2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 21 U.S.P.Q.2d 1031, 1034 (Fed Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. Kalman v. Kimberly-Clark Corp., 713 F .2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicant respectfully submits that Mendez does not teach every element of the claimed invention arranged as they are in the claims. Specifically, Mendez does not teach responsive to receipt of said message at the mail server, initiating a link between said mail server and said client using said remote device id, and wherein the step of initiating the link comprises: creating a first trigger message, transmitting said trigger message to a message server, at the message server, transmitting a second trigger message to the client

using a first protocol responsive to receipt of the first trigger message, at the client, initiating a client mailbox synchronise request to the mail server using a second protocol in response to the receipt of the second trigger message; and synchronising the client mailbox with the mail server mailbox using the second protocol such that said message is added to the client mailbox.

Mendez is directed to a system that includes an e-mail engine which uses a proper protocol to retrieve an e-mail from a first mail store and to store the e-mail in one or more folder structures. Upon request, the first mail store may send configuration data indicating the proper protocol to the e-mail engine, which can then properly configure itself. An e-mail synchronization module uses a predetermined criterion to determine whether the e-mail was previously sent and whether to synchronize the e-mail with a second mail store. The e-mail synchronization module may also synchronize the e-mail of specific folder structures. The second mail store may be located on a global server, which upon proper identification and authentication provides roaming users with access to its contents. A communications module establishes a communications channel through any firewalls with the second mail store. A web engine sends the e-mail via the communications channel to the second mail store.

Mendez does not teach responsive to receipt of said message at the mail server, initiating a link between said mail server and said client using said remote device id. The Final Office Action alleges that this feature is taught at column 12, lines 1-39, which read as follows:

> The LAN 810 includes a network server 845 coupling the LAN firewall 870 via a system bus 855 to a client 840 and to a mail server 850. The mail server 850 receives and stores in one or more folder structures client electronic mail 875 (e-mails) from the computer network 820 and addressed to the client 840. The client 840 includes an e-mail synchronization system 860 for downloading client e-mails 875 from the mail server 850 and storing them locally in one or more folder structures as "downloaded e-mails 865." To communicate therebetween, the mail server 850 and the e-mail engine 965 must both use the same transmission protocol such as the third version of the Post Office Protocol (POP3), the Vendor-Independent Messaging (VIM) protocol developed by the Lotus Development Corporation, or the Messaging Application Program Interface (MAPI) protocol developed by the Microsoft Corporation. Each e-mail in the LAN 810 is stored in a predetermined format, referred to as

Format A, which is determined by the e-mail engine 965 (FIG. 9) on the LAN 810 that downloaded it.

It will be appreciated that, after being downloaded, the client e-mails 875 corresponding to the downloaded e-mails 865 may be deleted from the mail server 850. The e-mail synchronization system 860 further synchronizes the downloaded e-mails 865, the client e-mails 875 or possibly only the e-mails of a specific folder structure (e.g., a user's unanswered mail folder or joke folder) with the global server 835. The e-mail synchronization system 860 is described in greater detail below with reference to FIG. 9.

The ISP mail server 894 and the client 897 operate in a similar manner to the mail server 850 and the client 840. Generally, the ISP mail server 894 receives e-mails from the computer network 820 which are addressed to the client 897, and stores them locally in one or more folder structures as "client e-mails 896." The e-mail synchronization system 898 of the client 897 uses an e-mail engine 965 (FIG. 9) to download client e-mails 896 and store them locally in one or more folder structures as "downloaded e-mails 899." The e-mail engine 965 of the client 897 stores the e-mails in Format B, which may be different than Format A. The e-mail synchronization system 898 then synchronizes the client e-mails 896, the downloaded e-mails 899 or possibly the e-mails of specific folder structures with the global server 830.

In this section, Mendez describes a configuration of a computer network, which is comprised of a Local Area Network coupled via a communications channel to a computer network such as the Internet. In this configuration the client uses an email synchronization system that has an e-mail engine to download client e-mails and store them locally in one or more folder structures. Nowhere in this section, or any other section of Mendez is a configuration described where a link between the mail server and the client is initiated using a remote device id in response to receipt of a message at the mail server.

In response to Applicant's arguments the Final Office dated May 4, 2005, states:

> As to applicant's argument Mendez disclosed and also recited by the applicant " The mail server 850 receives and stores in one or more folder structures client electronic mail 875 (e-mails) from the computer network 820 and addressed to the client 840 (col. 12, lines 3-7). One ordinary skill in the art at the time of the invention interpreted the function of receiving, sending and saving emails would resulted in establishing communication link between the client and the receiver.

Applicant respectfully submits that, while Mendez may establish a communication link, the communication link is not established in response to receipt of a message at the mail server, as recited in the presently claimed invention. As discussed previously, Mendez teaches establishing a link in response to a client initiating the communication link. Applicant is not merely claiming initiating a link, but initiating a link in response to the receipt of a message at the mail server.

Moreover, Mendez actually teaches away from this type of configuration by teaching a synchronization-start module within the client system that determines when to initiate e-mail synchronization. Mendez specifically teaches that communication with the synchronization agent of the global server preferably initiates from within the LAN, because a security system such as the typical firewall prevents inbound communications and allows out-bound communications. The synch-start module of the client may instruct the communications module to establish the communications link with the synchronization agent of the global server. See column 14, line 61 to column 15, line 11. The client initiation of synchronization-start module may initiate e-mail synchronization upon user request, at a particular time of day, after a predetermined time period passes, after a user action such as user log-off or upon like criteria. Nowhere does Mendez teach initiating a link between the mail server and the client using a remote device id in response to receipt of a message at the mail server.

Therefore, Mendez also does not teach initiating a link by creating a first trigger message, transmitting the trigger message to a message server, at the message server, transmitting a second trigger message to the client using a first protocol responsive to receipt of the first trigger message, at the client, initiating a mail box synchronise request to the mail server using a second protocol in response to the receipt of the second trigger message. While Mendez may initiate synchronization at the client, it is not in response to a message sent from the mail server.

Thus, Mendez does not teach each and every feature of independent claims 1, 13 and 23 as is required under 35 U.S.C. § 102. At least by virtue of their dependency on independent claims 1 and 13, the specific features of dependent claims 2-7, 10-12, 14-18 and 20-22 are not taught by Mendez. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1-7, 10-18 and 20-23 under 35 U.S.C. § 102.

Furthermore, Mendez does not teach, suggest or give any incentive to make the needed changes to reach the presently claimed invention. Absent the Examiner pointing out some teaching or incentive to implement Mendez such that a link between the mail server and the client is initiated using a remote device id in response to receipt of a message at the mail server, one of ordinary skill in the art would not be led to modify Mendez to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion or incentive to modify Mendez in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicant's disclosure as a template to make the necessary changes to reach the claimed invention.

Moreover, in addition to their dependency from independent claims 1 and 13, the specific features recited in dependent claims 2-7, 10-12, 14-18 and 20-22 are not taught by Mendez. For example, with regard to claims 3 and 15, Mendez does not teach wherein the step of initiating a link to said client comprises executing an agent, wherein the agent initiates a call to the client using said remote device id. The Final Office Action alleges that this feature is taught at column 14, lines 23-39, which reads as follows:

> The communications module 1005 includes routines for compressing data and routines for establishing a communications link via the communications interface 925 (FIG. 9) with the synchronization agent 885 (FIG. 8). The communications module 1005 may further include routines for applying Secure Socket Layer (SSL) technology and user identification and authentication techniques (i.e., digital certificates) to establish a secure communication channel through the global firewall 880.

In this section, Mendez describes a communication module, which is part of a base system that also includes a user interface module, locator modules, a synchronization-start module and an e-mail synchronization module. Thus the described communication module is part of the client and Mendez is actually teaching the client initiating a communications link with the server.

As additional examples, with regard to claims 4, 7 and 16, Mendez does not teach wherein the agent initiates the call to the client by: creating the first trigger message, said first trigger message comprising the remote device id; transmitting said first trigger message to the message server; and responsive to receipt of said first trigger message at the message server, initiating said link between the mail server and the client in order to

perform said synchronization, and wherein the step of initiating a link to the client further comprises: receiving the first trigger message at said message server; looking up the remote device id contained within said first trigger message in the message server's address book; mapping said remote device id to the corresponding contact details; and using said details to transmit the second trigger message to the client. As discussed above, Mendez teaches initiating a communications link and a synchronization call to the server from the client.

Therefore, in addition to being dependent on independent claims 1 and 13, dependent claims 2-7, 10-12, 14-18 and 20-22 are also distinguishable over Mendez by virtue of the specific features recited in these claims. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 2-7, 10-12, 14-18 and 20-22 under 35 U.S.C. § 102.

II. 35 U.S.C. § 103, Alleged Obviousness, Claims 8, 9 and 19

The Final Office Action rejects claims 8, 9 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Mendez et al. (U.S. Patent No. 5,961,590) and Lefeber et al. (U.S. Publication No. 2002/0046299 A1). This rejection is respectfully traversed.

Claims 8, 9 and 19 are dependent on independent claims 1 and 13 and, thus, these claims distinguish over Mendez for at least the reasons noted above with regards to claims 1 and 13. Moreover, Lefeber does not provide for the deficiencies of Mendez and, thus, any alleged combination of Mendez and Lefeber would not be sufficient to reject independent claims 1 and 13 or claims 8, 9 and 19 by virtue of their dependency. That is, Lefeber does not teach initiating a link between the mail server and the client using a remote device id in response to receipt of a message at the mail server.

In response to Applicant's arguments the Final Office dated May 4, 2005, states:

> As to applicant's argument Lefeber disclosed "wherein the device hangs up after a specified number of ring and delays or after sufficient time for the server to capture caller ID information would be received by a server that the alert was received and/or that the user took action and signaling server could ease efforts to notify the user (Page. 6, Column. 0051)". One ordinary skill in the art at time of the invention interpreted "caller ID

information" as "Remote device ID" and "receiving the alert" also as interpreted as "receiving the message".

Applicant respectfully submits that, while Lefeber may use caller ID information, Lefeber does not teach or suggest initiating a link between the mail server and the client using a remote device id in response to receipt of a message at the mail server. Thus, the combination of Mendez teaching the establishment of a link in response to a client initiating the communication link and Lefeber teaching a caller ID, still does not teach or suggest the presently claimed invention of initiating a link between the mail server and the client using a remote device id in response to receipt of a message at the mail server.

Moreover, the Final Office Action may not use the claimed invention as an "instruction manual" or "template" to piece together the teachings of the prior art so that the invention is rendered obvious. In re Fritch, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of Applicant's disclosure. Id. Therefore, absent some teaching, suggestion, or incentive in the prior art, Mendez and Lefeber cannot be properly combined to form the claimed invention. As a result, absent any teaching, suggestion, or incentive from the prior art to make the proposed combination, the presently claimed invention can be reached only through an impermissible use of hindsight with the benefit of Applicant's disclosure as a model for the needed changes.

In view of the above, Mendez and Lefeber, taken either alone or in combination, fail to teach or suggest the specific features recited in independent claims 1 and 13, from which claims 8, 9 and 19 depend. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 8, 9 and 19 under 35 U.S.C. § 103.

III. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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